

Applicant : Michelle R. Dalton
Serial No. : 09/499,249
Filed : February 7, 2000
Page : 9 of 12

Attorney's Docket No.: 07844-370001 / P345

REMARKS

Claims 1-32 were pending as of the action mailed on March 13, 2006.

The specification is amended to correct typographical errors.

Claims 1, 11, 21-26, 31, and 32 are amended. No new matter has been added. These amendments are supported, *e.g.*, on page 6, lines 4-5, of the specification.

Reexamination and reconsideration of the action are requested in light of the foregoing amendments and the following remarks.

Section 102

Claims 1-32 were rejected as allegedly anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 6,256,108 ("Dziesietnik").

The examiner rejects all of claims 1-32 with a common description of Dziesietnik that does not address the actual limitations of any of the claims. To put it more plainly, the examiner has failed to read the limitations of the claims onto the reference. For this reason, the applicant submits that the action fails to comply with 35 U.S.C. § 132 and 37 C.F.R. § 1.104(c)(2) and on that ground requests that the action be withdrawn.

The requirements of 35 U.S.C. § 132 are explained in the M.P.E.P. in § 707, which states:

In accordance with the patent statute, "Whenever, on examination, any claim for a patent is rejected, or any objection . . . made", notification of the reasons for rejection and/or objection together with such information and references as may be useful in judging the propriety of continuing the prosecution (35 U.S.C. 132) should be given.

When considered necessary for adequate information, the particular figure(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s), and/or any relevant comments briefly stated should be included. . . .

These requirements have not been met in the present case. As explained in 37 C.F.R. § 1.104(c)(2):

When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of

Applicant : Michelle R. Dalton
Serial No. : 09/499,249
Filed : February 7, 2000
Page : 10 of 12

Attorney's Docket No.: 07844-370001 / P345

each reference, if not apparent, must be clearly explained and each rejected claim specified.

In the present case, the Dziesietnik patent is a lengthy reference. This reference is "complex" and "describes inventions other than that claimed by the applicant". The action should therefore have designated "the particular part relied on . . . as nearly as practicable" in reference to the claims. The action did not do this.

The only reference that the examiner makes to any specific portion of Dziesietnik is in the closing parenthetical of the single paragraph in which the examiner explains the rejection, which reads: "Please note: col 5, line 23 – col 11, line 5," a citation to almost 6 columns of the reference. This does not come close to the specificity required by the statute and rules. A claim rejection violates 35 U.S.C. § 132 if it "is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection." *Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990). On this basis, the applicant submits that the rejections of claims 1-32 should be withdrawn.

The applicant infers that the examiner has read the "container" of the claims onto the "label" of Dziesietnik. If this is the case, then the examiner presumably read the recited limitation of "creating a high-level representation of the container as a separated element" on label processing, which is described in Dziesietnik as follows:

Label preprocessing (FIG. 3) transforms an encoded CMYK label into a color separated representation. This representation is such that an expander may be started at the beginning of any of a set of special scanlines which impose a swath structure onto the label. Label preprocessing also creates a Pixel Type Map of the label. This map defines each pixel's characteristics (discussed in greater detail below). [Co. 6, lines 24-30]

Earlier, Dziesietnik had earlier explained that:

VarPages are composed by merging pregenerated labels. Labels are color separated, encoded (e.g. Using document compression comprising SDSO and JPEG) rectangular patches. SDO is a run length based encoding scheme that overlays another compression scheme which may be grid aligned and applied arbitrarily to a page (such as JPEG). See, for example L. Pardo, Image Rendering for Page Printers, PCT Application No. WO 97/02542, and Y.

Applicant : Michelle R. Dalton
Serial No. : 09/499,249
Filed : February 7, 2000
Page : 11 of 12

Attorney's Docket No.: 07844-370001 / P345

Accad, Apparatus and Method for Hybrid Compression of Raster Data, U.S. patent application Ser. No. 08/773,656, filed Dec. 24, 1996. [Col. 5, lines 31-41]

Later, Dziesietnik explains that:

An expander subsystem 43 has two input streams, i.e. an SDSO stream and a JPEG stream. [Col. 9, lines 8-9]

Thus, Dziesietnik teaches that labels are color separated and encoded using "SDSO" in a representation that is such that an expander may be started at any of a special set of scanlines, and that an expander has an "SDSO" input stream.

However, for a reference to anticipate a claim, the reference must be enabling. *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 1 U.S.P.Q.2d 1241, 1245, 808 F.2d 1471, 1479 (Fed. Cir. 1986) ("the prior art reference must be enabling, thus placing the allegedly disclosed matter in the possession of the public"). The Dziesietnik reference is not enabling because it does not describe how to create the color separated representation that is referred to, and in particular it does not even describe what an SDSO encoding or stream is, let alone enable one to make such an encoding.

For this additional reason, the applicant submits that the rejections of claims 1-32 should be withdrawn.

Moreover, the examiner failed to address in any way meaningful limitations found in claims other than claim 1. In particular, nothing in the action appears to find in Dziesietnik the features of "creating a separation context to capture one or more separated containers" (claims 2 and 12); "decomposing each container into one or more elements" and "recursively performing color separation for each element" (claims 5 and 15); "reconstructing each container as an object" (claims 6 and 16); "creating a high-level representation of the pattern container as a separated element" (claim 31); or "creating a high-level representation of the form XObject as a separated element" (claim 32).

For this additional reason, the applicant submits that the rejections of claims 2, 5, 6, 12, 15, 16, 31, and 32 and their respective dependent claims should be withdrawn.

Applicant : Michelle R. Dalton
Serial No. : 09/499,249
Filed : February 7, 2000
Page : 12 of 12

Attorney's Docket No.: 07844-370001 / P345

Finally, in order to expedite prosecution, the applicant has amended each of the independent claims to include a definition of the high-level representation recited in the claims. This definition is found in the specification, on page 6, lines 4-5, and so including the definition does not narrow the scope of the claims. In light of this definition, which states that the high-level representation is a non-bitmapped representation, none of the independent claims can be deemed anticipated by Dziesietnik, because all of the representations of labels described by Dziesietnik are clearly raster - i.e., bitmapped - representations.

Conclusion

For each of the foregoing reasons, the applicant submits that all the claims are in condition for allowance.

By responding in the foregoing remarks only to particular positions taken by the examiner, the applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the applicant's arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 13 Jun 06



Hans R. Froesch
Reg. No. 36,950

Customer No. 21876
Fish & Richardson P.C.
Telephone: (650) 839-5070
Facsimile: (650) 839-5071

50337635.doc